

**REMARKS**

This is a full and timely response to the outstanding final Office Action mailed August 07, 2007. Through this response, claims 1, 3-11, 17, and 19-27 have been cancelled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 12, 13, 15, 16, 28, 29, 31, and 32 are respectfully requested.

**I. Claim Rejections - 35 U.S.C. § 102(e)**

**A. Statement of the Rejection**

Claims 1, 2, 4-7, 11, 12, 16-18, 20-23, 27, 28, and 32 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Ishida et al.* ("*Ishida*," U.S. Pat. No. 6,661,839). Applicant respectfully traverses this rejection where not rendered moot by cancellation of the claims.

Applicant respectfully notes that the final Office action is confusing in that page 5 asserts that claim 12 "is rejected for the same reasons as per claim 1." Similarly, the final Office Action on page 6 alleges that claim 28 "is rejected for the same reasons as claim 17." However, Applicant respectfully notes that claims 1 and 17 lack the below-emphasized features found in claims 12 and 28, respectively, and that those emphasized features are not addressed in the rejection to claims 1 and 17.

Additionally, the confusion is perpetuated by the fact that the "Response to Arguments" section on page 3 appears to attempt to address the arguments presented in support of patentability of claims 12 and 28 in Applicant's last response, but uses *Wang* and fails to address the explicit claim features. Accordingly, Applicant queries whether the rejection to claims 12 and 28 is based on 103(a) (*Ishida* and *Wang*), 102(e) (*Wang*), or 102(e) (*Ishida*). Further, Applicant respectfully submits that the failure to address the explicit claim features renders the rejection improper under MPEP 706 (e.g., 37 CFR 1.104),

and hence Applicant respectfully requests that the next Office Action, if not a Notice of Allowance, be made non-final to accord Applicant an adequate opportunity to address any rejection of the explicit claim features and clarify issues for appeal.

Applicant will assume for purposes of advancing prosecution on the merits that the rejection of the below emphasized claim features is to be addressed under 35 U.S.C. 103(a), and hence the rejection under 102(e) will briefly point out the deficiencies of *Ishida*.

## B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every claimed feature is represented in the *Ishida* reference. Applicant discusses the *Ishida* reference and Applicant's claims in the following.

### Independent Claim 12

Claim 12 recites (with emphasis added):

12. A method for adaptively compressing test data to be provided to a device under test (DUT), the method comprising the steps of:
  - examining a test data file that includes test data configured to enable testing the DUT, the test data file including a first plurality of data units and a second plurality of data units, the first plurality of data units corresponding to a first plurality of DUT pins, and the second plurality of data units corresponding to a second plurality of DUT pins, **wherein the first plurality of DUT pins are clock-pins and the second plurality of DUT pins are non-clock-pins;**
  - determining that the first plurality of data units have a first compressibility characteristic; and
  - determining that the second plurality of data units have a second compressibility characteristic.

Applicant respectfully submits that *Ishida* fails to disclose, teach, or suggest at least the above emphasized claim features. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 12 is allowable over *Ishida*, dependent claim 16 is allowable as a matter of law for at least the reason that the dependent claim 16 contains all elements of it's respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

#### **Independent Claim 28**

Claim 28 recites (with emphasis added):

28. A system for adaptively compressing test data to be provided to a device under test (DUT), the system comprising:  
memory configured to store a test data file that includes test data configured to enable testing the DUT, the test data file including a first plurality of data units and a second plurality of data units, the first plurality of data units corresponding to a first plurality of DUT pins, and the second plurality of data units corresponding to a second plurality of DUT pins, ***wherein the first plurality of DUT pins are clock-pins and the second plurality of DUT pins are non-clock-pins***; and  
a processor that is operative to:  
determine that the first plurality of data units have a first compressibility characteristic;  
determine that the second plurality of data units have a second compressibility characteristic.

Applicant respectfully submits that *Ishida* fails to disclose, teach, or suggest at least the above emphasized claim features. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Because independent claim 28 is allowable over *Ishida*, dependent claim 32 is allowable as a matter of law.

Due to the shortcomings of the *Ishida* reference described in the foregoing, Applicant respectfully asserts that *Ishida* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

### **A. Statement of the Rejection**

Claims 3, 8, 9, 13, 14, 19, 24, 25, 29 and 30 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ishida* and further in view of *Wang et al.* ("*Wang*," U.S. Publication No. 2006/0242502). Claims 10, 15, 26 and 31 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Ishida* and further in view of *Testa et al.* ("*Testa*," U.S. Pat. No. 6205407). Applicant respectfully traverses these rejections where not rendered moot by cancellation of the claims.

### **B. Discussion of the Rejection**

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquiries, also expressed in MPEP 2100-116, are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Applicant respectfully submits that a *prima facie* case of obviousness is not established using the art of record.

### **Claim 12**

As set forth above, Applicant respectfully submits that claim 12 is allowable over *Ishida*. The final Office Action alleges the following on page 3 (no emphasis added):

The Examiner re-iterates that Wang in FIG. 1, reference characters (110) and (113) teaches combinational logic test pins. Combinational logic is inherently non-clock signals to those of ordinary skill in the art. Also, Wang in FIG 1, reference characters (108), (109) and (111) teaches SC "Scan

Chain" test pins. Scan chain is inherently clock signals to those of ordinary skill in the art.

Applicant respectfully disagrees. Even assuming *arguendo* Wang teaches scan chains, Wang does not disclose that the test pins 108, 109 and 111 are **clock pins**. Indeed, Applicant has reviewed several technical articles (e.g., <http://www.ics.uci.edu/~nodari/vts2003.pdf>, <http://www.caip.rutgers.edu/~bushnell/dsdwebsite/dsdlecture26.ppt>, [http://www.jtag.com/main.php?cm=p8\\_1\\_\\_\\_\\_](http://www.jtag.com/main.php?cm=p8_1____)) and has found no evidence to support the Examiner's conclusion that a "scan chain is inherently clock signals." Quite the contrary, the inputs to the scan chains described and shown in the articles referenced above appear to be non-clock signals.

Further, even assuming *arguendo* evidence can be presented to support clock signal inputs to a scan chain, that evidence alone (in view of other literature such as disclosed above) cannot support an inherency argument since, as set forth in a recent Federal Circuit court decision:

"[A]nticipation by inherent disclosure is appropriate only when the reference discloses prior art that must necessarily include the unstated limitation." *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006).

Additionally, Applicant respectfully notes that the explicit claim features are to **clock-pins**, not clocked pins. Accordingly, Applicant respectfully requests that the rejection to claim 12 be withdrawn.

#### **Claim 28**

For similar reasons set forth in association with claim 12, Applicant respectfully submits that Wang and Ishida fail to disclose, teach, or suggest at least the features emphasized above for claim 28. Accordingly, Applicant respectfully requests that the rejection to claim 28 be withdrawn.

### **Claims 13 and 29**

Applicant respectfully submits that *Ishida* fails to disclose, teach, or suggest at least the above-emphasized features of independent claims 12 and 28. Further, Applicant respectfully submits that *Wang* fails to remedy these deficiencies. For at least the reason that *Ishida* and *Wang* fail to disclose, teach, or suggest at least the features emphasized above for independent claims 12 and 28, dependent claims 13 and 29 (which incorporate the respective allowable base claim features) are allowable as a matter of law. Accordingly, Applicant respectfully requests that the rejection to claims 13 and 29 be withdrawn.

### **Claims 15 and 31**

Applicant respectfully submits that *Ishida* fails to disclose, teach, or suggest at least the above-emphasized features of independent claims 12 and 28. Further, Applicant respectfully submits that *Testa* fails to remedy these deficiencies. For at least the reason that *Ishida* and *Testa* fail to disclose, teach, or suggest at least the features emphasized above for independent claims 12 and 28, dependent claims 15 and 31 (which incorporate the respective allowable base claim features) are allowable as a matter of law. Accordingly, Applicant respectfully requests that the rejection to claims 15 and 31 be withdrawn.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the art of record and that the rejection of these claims should be withdrawn.

### **III. Canceled Claims**

As identified above, claims 1, 3-11, 17, and 19-27 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicant respectfully submit that Applicant's pending claims are in condition for allowance. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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